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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,534	12/12/2003	Joseph C. Walsh	PP 5.76(a)	2689

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Michael A. Goodwin, Esq.
Klaas, Law, O'Meara & Malkin, P.C.
Suite 2225
1999 Broadway
Denver, CO 80202

EXAMINER

FOSTER, JIMMY G

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 07/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/735,534

Applicant(s)

WALSH ET AL.

Examiner

Jimmy G Foster

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-30 is/are pending in the application.
- 4a) Of the above claim(s) 20-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 26-30 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 20-25, drawn to an application adhesive machine machine, classified in class 493, subclass 121+.

II. Claims 26-30, drawn to a bottle carrier, classified in class 206, subclass 187.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case the apparatus can make a different product such as one in which the adhesive is provided as a strip that is parallel to the spine fold.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

2. During a telephone conversation with the Michael Goodwin on 19 May 2004 a provisional election was made presumably with traverse to prosecute the invention of II, claims 26-30. Affirmation of this election must be made by applicant in replying to this Office action. **Claims 20-25 are therefore**

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withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

4. The Prior art cited in the parent patent 6,689,034 has been considered in the examination of this application.

5. Claim 29 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 29 calls for an adhesive strip to attach a first portion of the first half to a second portion of the first half. Due to antecedent basis, this is the same adhesive strip set forth in the last paragraph of claim 26 from which claim 29 depends, wherein the adhesive strip is claimed as being on an adhesive line transverse to the spine fold line and as adhering the first half of the carrier to the second half. But none of the embodiments disclosed by Applicant appear to include a single strip of adhesive that both attaches portions of a first half of the carrier together and adheres the first half to the second half.

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6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 26, 27, 29 and 30 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Forrer et al (3,572,543). Applicants' use of the claim term "half," when considered in light of the specification, in which the portions of the carrier on either side of the spine fold (D) are described as halves, is not considered to require that the halves claimed be identical since the portions of the carrier embodiments disclosed are not identical.

In the reference of Forrer et al, there is provided a first half defined by panels 8,2,1,3,10 and a second half defined by panels 35,39,41,40,36. The halves are separated by a spine fold/medial fold line 29.

In Figure 5 each of panels 8, 10, 35 and 36 has adhesive/glue applied to its surface in a manner indicated by the stippling shown, which in each

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case is in the form of a strip whose line is extended transverse to the spine fold 29.

In addition, the adhesive located on the surface of panel 35 and portion of the surface of panel 27, as shown in Figure 4, is asserted by the examiner (1) as being on an adhesive line transverse to the spine fold 29, (2) as including the portion thereof on panel 27 which will attach the panels 12 and 27 of the halves together, and (3) as including a portion on the surface of panel 35 (as seen in Figure 4) which will attach first-half portion/panel 35 to the first-half portion/panel 27. See the description in the first paragraph of column 3.

It is well settled that the patentability of a product ordinarily can not depend on its method of being made. See In re Thorpe, 777 F.2d 695, 227 USPQ 964 (1985). Also note MPEP 706.03(e), In re Brown, 59 CCPA 1063, 173 USPQ 685 (CCPA 1972); In re Fessmann, 180 USPQ 324 (CCPA 1974) regarding the Office's lesser burden of proof in product-by-process claims. Accordingly, although the reference of Forrer et al does not disclose the method step of extruding the adhesive or glue on the panels 8,10,35,36, the claims of Applicants are claiming a product and not the method of making the product (in the elected claims), and any one of the Forrer et al strips of adhesive/glue on said panels reads on the adhesive strip claimed by Applicant since it constitutes an adhesive strip.

Alternatively, the reference of Forrer et al discloses that the glue used in constructing the carrier may be hot-melt adhesive, for the purpose of using an adhesive that does not cause moisture to enter the paperboard and weaken the paperboard (col. 4, lines 52-59). Additionally, Applicants admit that it is known to dispense hot-met adhesive onto a package using a nozzle to do so, in that Applicants admit that hot-glue is "commonly dispensed from

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a nozzle" (page 3, lines 31-31; also see entire paragraph beginning on line 24 of page 3, and see conventional hot glue nozzle in Figure 1, as described by Brief Description of the Drawings), which is actuated by a solenoid which, in turn, is controlled by a control system. The act of dispensing from a nozzle constitutes extrusion. Accordingly, it would have been obvious in view of Applicants' admission regarding controlled dispensing (extruding) hot-melt adhesive through a nozzle, to have employed a nozzle for extruding the hot-melt adhesive of Forrer et al onto the panels 8,10,35,36, for the purpose of controlling the application of the hot-melt adhesive.

9. Claims 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Forrer et al in view of Applicants' admission of prior art with respect to it being known to make a package substrate from a lamination of a paperboard layer and a film layer for the purpose of providing strength to the paperboard layer and therefore permitting the paperboard layer to be thinner. See page 1, line 8 through page 2, line 11. Accordingly, it would have been obvious in view of this admission to have made the material of the carrier of Forrer et al as a lamination of a paperboard layer and a film layer, to permit the paperboard layer to be thinner by added strength to the material with the film layer.

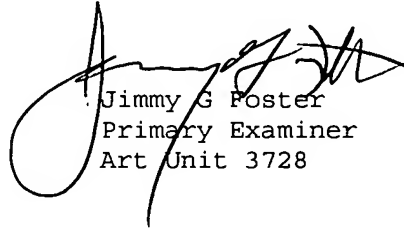
1. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jimmy G Foster whose telephone number is (703) 308-1505. The examiner can normally be reached on Mon-Fri, 8:45 am - 5:15 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (703) 308-2672. The fax

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phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.



Jimmy G Foster
Primary Examiner
Art Unit 3728

JGF
8 July 2004